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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In Application of:	Killick)	
Serial No.	09/520,576)	Confirmation No. 1427
Filed:	March 8, 2000)	Art Unit: 3622
For:	Disaggregated Databases for Tracking Consumer Purchasing Data)	Examiner: Duran, Arthur D.

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sirs:

Pursuant to 37 C.F.R. §1.193, and responsive to the Examiner's Answer mailed on May 5, 2005, the Applicant submits this Reply Brief to the Board of Patent Appeals and Interferences. This Reply Brief is timely within the time period set forth in 37 C.F.R. 1.193, which provides that the appellant must file a reply brief within two months from the date of the Examiner's Answer.

I hereby certify that this paper or fee is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Appeal Brief – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on July 5, 2005.

William R. Silverio

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I. Appellant's Reply To The Examiner's Answer

Appellant respectfully disagrees with the Examiner's interpretation of the references cited in the outstanding 35 U.S.C. §103 rejection, and asserts that the Examiner has failed to establish a *prima facie* case of obviousness pursuant to 35 U.S.C. § 103.

A. The Examiner Provides No Motivation to Combine the References

In the Examiner's Answer, the Examiner argues that the cited references all pertain to recording user purchasing behavior at POS [Point of Sale] systems. (Examiner's Answer, Page 14). The Examiner then contends that because the references have "mutual objectives" they are properly combinable in the 35 U.S.C. §103 rejection. *Id.* at 15. The Examiner further relies on the statements made in the Final Office Action to evidence proper motivation to combine the references. *Id.*

Applicant maintains that the Examiner's position regarding motivation to combine the references is untenable, as the Examiner fails to provide any clear or particular motivation to combine the references, including why one of ordinary skill in the art would have desired to make the recited combination. As such, the Examiner has failed to meet a *prima facie* case of obviousness. In particular, the Examiner fails to provide sufficient motivation to combine U.S. Patent No. 6,327,570 to Stevens ("Stevens") with the article "What Grocers Want in Electronic Marketing Programs" ("*What Grocers Want*"), and with U.S. Patent No. 6,321,208 to Barnett ("*Barnett*"). The Examiner further fails to provide sufficient motivation to combine *What Grocers Want* with *Barnett* and U.S. Patent No. 6,024,288 to Gottlich ("*Gottlich*").

First, *Stevens* discloses a system including a personal data device that is worn by a consumer and which communicates with products and private store networks. The system

disclosed by *Stevens* can include a master control node in communication with a business network having in-store local communication units, which are, in turn, in communication with a customer's personal data device when the customer is near or in a store. The system provides targeting marketing when the consumer's device is near a display, product, or other object with a communications microchip. In rejecting the independent claims under 35 U.S.C. §103, the Examiner admits that *Stevens* fails to disclose the selective extraction of consumer data for analysis and the analysis of consumer data by a computer program. (Final Office Action, Pages 2-4).

To provide the selective extraction of consumer data that *Stevens* lacks, the Examiner combines *Stevens* with *What Grocers Want*. *What Grocers Want* discloses only a POS frequent shopper system that can track the purchase of select products by a participating user that identifies themselves using a card (e.g., a frequent shopper card) at a POS device. The thrust of the article is that retailers want local control over electronic frequent shopper programs. To effect such systems, a POS system will identify a user via their identifying card and subsequently store only data pertaining to certain purchases made by the consumer. *What Grocers Want* reveals that consumer purchase data is matched up against information the user provided to the retailer upon signing up for the program – and though it generally states that a “frequent shopper feature” may be put on a debit card, it fails to suggest that any information, other than the user's identity, is stored on the consumer's card.

The Examiner's motivation to combine *Stevens* and *What Grocers Want* is that it would have been obvious to extract only a portion of information, as taught in *What Grocers Want*, with *Stevens* to avoid the gathering of too much information and to limit the memory required in a consumer device. (Final Office Action, Page 3). The Examiner does not discuss what information is *selectively* extracted from the consumer card in *What Grocers Want*, which may

contain only the user ID, a frequent shopper number, or the like. The Examiner also fails to provide any specifics as to why one of ordinary skill in the art would have combined the teachings of a card-based POS frequent shopping program with that of a wireless personal data device that is operable to receive direct marketing. For instance, the Examiner fails to describe how a POS frequent shopping card system would be relied on by a distributed wireless marketing system, especially when the POS frequent shopping card system encourages local control of data received at a POS device. Moreover, the Examiner describes both *Stevens* and *What Grocers Want* generically as relating to purchasing behavior at POS systems, even though *Stevens* relates to a marketing system that permits targeting advertising without requiring a POS device as is used in *What Grocers Want*. That in hindsight of applicant's disclosure a skilled artisan arguably may be able to recognize, cull, modify, and combine certain claim elements from disparate references is not evidence of a clear and particular motivation to combine those references. *See, e.g., In re Lee*, 61 U.S.P.Q.2d 1430, 1433-34 (Fed. Cir. 2002). The Examiner's statements concerning motivation are entirely conclusory, and are insufficient to establish a prima facie case of obviousness.

The Examiner also uses *Barnett* to provide the analysis of consumer data by a computer program, which is not provided by either *Stevens* or *What Grocers Want*. (Final Office Action, Pages 3-4). However, the addition of *Barnett* to the combination of *Stevens* and *What Grocers Want* also fails to provide motivation to combine two or more of the three references. The sole recitation for motivation to combine *Barnett* with *Stevens* and *What Grocers Want* is "more expansive and flexible options for consumer analysis". *Id.* at 4. *Barnett* discloses a method and system for electronic distribution of product redemption coupons to remote personal computers at users' homes. (*Barnett*, Abstract). A user, at their home, may print coupons for later use in a store. The user's coupon selection data is provided back to the online service for marketing

analysis. *Id.* Though custom offers, such as coupon packages, may be offered to consumers, all of the information concerning a user's coupon selection is uploaded to the central repository for marketing analysis. No selective extraction exists. Additionally, in *Barnett* there is no POS system, and there is no consumer device associated with anything other than the user's home computer. Although *Barnett* discloses generating marketing information based on the downloading, at a user's home, of coupons, the Examiner offers no explanation as to why *Barnett* may be, or should be, combined with *Stevens* and *What Grocers Want*. Thus, not only does the Examiner's expedient 'motivation' for *Barnett* fail to cure the lack of motivation to combine *Stevens* and *What Grocers Want* described above, it also fails as sufficient to add *Barnett* to the combination of *Stevens* and *What Grocers Want*, as it is entirely conclusory.

The Examiner's statements concerning motivation to combine *Gottlich*, *What Grocers Want* and *Barnett* are also insufficient to establish a *prima facie* case of obviousness pursuant to 35 U.S.C. § 103. Because the Examiner provides no additional arguments concerning motivation and relies only on the arguments provided in the Final Office Action (Examiner's Answer, Pages 15-16), Applicant relies on the arguments made in the Appeal Brief, and those detailing *What Grocers Want* and *Barnett*, as provided above, to maintain the inadequacy of motivation for the combination of *Gottlich*, *What Grocers Want*, and *Barnett*.

B. The Cited Art Does Not Establish a *Prima Facie* Case of Obviousness

The art cited by the Examiner fails to disclose or suggest a collection center that *instructs* a terminal device to extract consumer data from the consumer data acquisition device as recited in the independent claims. Responsive to the Applicant's Appeal Brief, the Examiner specifically references passages in each of the references the Examiner relies on to support the

rejection. However, the Examiner mischaracterizes the references, citing passages that fail to support the outstanding 35 U.S.C. § 103 rejection.

First, the Examiner states that *Stevens* discloses “communication and data exchange between a central source and a user device” (Examiner Answer, Page 8). The Examiner appears to interpret *Stevens* as divulging that the central source *instruct* the in-store communication units of *Stevens* to extract data from the user’s device. However, none of the passages cited by the Examiner support that position. As Applicant acknowledged in the Appeal Brief, *Stevens* discloses a system including a master or central node in communication with one or more databases (see col. 6, lines 61-67) and a business network having in-store local communication units in communication with a customer’s personal data device when the customer is near or in a store. However, *Stevens* does not disclose or suggest that a remote collection center dictate what information the in-store units extract from the data device. On the contrary, in *Stevens* the master control node simply receives data pushed to it from the personal data device, directly or via an in-store network.

Secondly, the Examiner contests the Applicant’s position that *What Grocers Want* fails to disclose or suggest an external collection center that is in active communication with a terminal device such as a Point of Sale (POS) terminal, where the collection center *instructs* the terminal to *extract* all or part of the consumer data from the consumer data acquisition device. The Examiner recites some short selections from *What Grocers Want* to refute the Applicant’s position. However, none of the Examiner’s selections disclose or suggest the use of a remote database that operates to selectively extract information from a consumer device, as recited in the outstanding Final Office Action. (Final Office Action, Pages 3 and 5). On the contrary, *What Grocers Want* fails to provide any suggestion that the information stored on a card may be selectively extracted. This is the basis for both of the Examiner’s 35 U.S.C. § 103 rejections.

On the contrary, it appears that the system in *What Grocers Want* simply retains product information at the POS terminal after identifying a user by extracting the identity of the user from the card, which the merchant uses to identify “information he has revealed about himself when he signed up for [the frequent shopper] program”. (*What Grocers Want*, Page 1). There is no disclosure in *What Grocers Want* that customer cards include a memory capable of retaining purchase data that may be extracted, much less selectively extracted.

Third, the Examiner uses *Barnett* in both of the outstanding rejections to provide the analysis of consumer data. In the Examiner’s Answer, the Examiner asserts that *Barnett* discloses, among other things: active solicitation or extraction of data on a consumer device, that a collection center can dictate what information is selectively extracted from a consumer device, such as a computer, by a terminal device. (Examiner’s Answer, Pages 13-14). *Barnett*, however, discloses a method and system for electronic distribution of product redemption coupons to remote personal computers at users’ homes. (*Barnett*, Abstract). A user, at their home, may print coupons for later use in a store. The user’s coupon selection data is provided back to the online service for marketing analysis. *Id.* Though custom offers, such as coupon packages, may be offered to consumers, all of the information concerning a user’s coupon selection is uploaded to the central repository for marketing analysis. No selective extraction occurs. Additionally, it will be appreciated that in *Barnett* there is no POS system, and there is no suggestion that the consumer device associated with anything other than the user’s home computer.

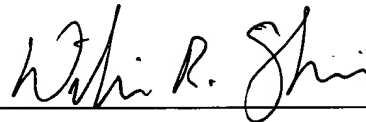
Applicant asserts that the Examiner mischaracterizes each of the above references, and relies on those mischaracterizations to form the outstanding rejections. Therefore, for the reasons set forth above Applicants assert that the Examiner has failed to meet a prima facie case of obviousness under 35 U.S.C. §103.

II. Conclusion

The Applicant respectfully requests that the Board overturn the rejection of the claims.

Any questions may be directed to the undersigned at 404.853.8214.

Respectfully submitted this 5th day of July 2005.

A handwritten signature in dark ink, appearing to read "William R. Silverio", is written over a horizontal line.

William R. Silverio
Reg. No. 45,383

SUTHERLAND ASBILL & BRENNAN LLP
999 Peachtree Street, N.E.
Atlanta, Georgia 30309-3996
(404) 853-8000
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